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REMARKS

Claims 1, 3, 8-17, 24, 25, 28-31, 33, and 35-40 are pending in this application. Claims 2, 5-7, 20, 26-27, 33 and 34 have been canceled without prejudice. The non-elected claims 4, 18, 19 and 21-23 are withdrawn.

Claims 1, 3, 4, 8-10, 14, 16, 24, 31, 35, 36, 38 and 39 have been amended to further clarify the free-flowing granular features of the composition of the invention in a *bona fide* effort to place the claims in condition for allowance. Claim 1 has been amended to replace the transitional phrase "comprising" with "consisting essentially of". Claim 35 has been amended to replace the transitional phrase "consisting essentially of" with "consisting of" and claim 38 has been amended to replace the transitional phrase "comprising" with "consisting of". Support for the amendments is found in the text of the Pre-Grant published application, US2008/0229512, in paragraph [0022] describing the conditioner combination; paragraph [0050] describing the ingredients and granularity of the free-flowing Component (A); in Examples 1 and 2 describing granular Component (A) and its preparation; in Example 5, paragraph [0083], describing the use of granular Component (A) to prepare a conditioning hair lightener emulsion; and in the description of granular Component (A) in Examples 8, 9, and 10.

No new matter is introduced by these amendments.

Request for Withdrawal of Final Rejection as Premature

The Office Action indicates that the Applicants' prior amendments necessitated the finality of the present rejection. This is clearly not the case.

Applicants respectfully submit that the Final Rejection was premature, because applicants' amendments filed February 20, 2009 did not necessitate new grounds for rejection or a new search as required by MPEP 706.07(a).

The amendments to claims 1, 8, 16, and 24, and the cancellation of claim 2, that were filed February 20, 2009 were merely foreseeable record clarifying amendments submitted in a *bona fide* response to the Examiner's rejections (now withdrawn) under 35 U.S.C. §112, second paragraph. The entire subject matter of dependent claim 2 reciting the combination of materials in the claimed conditioner species was simply incorporated into claim 1. Claim 1, in effect, is nothing more than original claim 2 in independent form. The subject matter of former dependent claim 2 was at all times present in the pending application under examination and during the Examiner's search for any art-based rejection that could have been previously raised

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by the prior art of record. Hence, the incorporated subject matter of former dependent claim 2 into claim 1, necessitating the cancellation of claim 2, cannot possibly raise new issues or require a new search.

The record clarifying amendment to the elected conditioner species in claims 1 and 8 merely included limitations which would reasonably be expected to be claimed, and the technical amendments clarifying the syntax of claims 16 and 24 were suggested by the Examiner. The foregoing amendments could not possibly necessitate a new ground of rejection. Applicants respectfully request reconsideration and withdrawal of the Final Rejection as premature as permitted by MPEP 706.07(d).

The Rejections Under 35 U.S.C. § 103(a)

Claims 1-3, 8, 9 and 35-40 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Narasimhan *et al.* (US Patent 6,238,653) in view of Lorenz *et al.* (US Patent 5,989,530) and Cincotta *et al.* (Pre-Grant Publication US2002/0155962). Applicants traverse this rejection in part by the further record clarifying amendments to claims 1, 3, 8, 9, 35, 36, 38 and 39 and the following discussion.

The present composition is directed to a substantially anhydrous, free-flowing granular composition comprising a water-dispersible, self-emulsifying, fatty acid-derived conditioner blend which comprises a combination of materials defined by the elected conditioner species recited in the claims. Furthermore, the claims as now presented have been amended to further clarify the features of the water-dispersible, self-emulsifying, fatty-acid derived conditioner blend of the combination of materials and the granularity of the claimed composition.

The claimed conditioner species is a non-aqueous ingredient blend, referred to as the "SFC" portion of the formulation in Table 1, and Table 2, for example, and is physically admixed with the dry ingredients of the powder portion of the resulting free-flowing granular composition. (See Examples 1, 2, 8, 9 and 10). The prior art does not teach Applicants' conditioner blend of the combination of materials or that the separately known materials are self-emulsifying when combined as taught by Applicants. Applicants claimed granular composition is maintained in free-flowing granular form as an article of manufacture until it is ready for use. When the free-flowing granular composition of the present invention is later admixed immediately before use with an aqueous medium, a conditioning hair lightener emulsion surprisingly forms substantially immediately (i.e., within 5 minutes as defined in paragraph

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[0043] of the Pre-Grant published application US2008/0229512) with minimal manual mixing agitation (see paragraph [0043] of the published application). The resulting so-formed hair lightener emulsion surprisingly beneficially ameliorates one or more deleterious effect on the tensile and tactile properties of hair oxidatively lightened under relatively high alkaline conditions, even when no hair protectant, deswelling agent is present (See Examples 5-7).

In direct contrast, the composition of Narasimhan *et al.* is not a free-flowing granular composition. Narasimhan *et al.* teach only liquid aqueous hydrogen peroxide compositions and require the formation and presence of nematic or smectic lyotropic liquid crystals as defined starting in column 2, line 66 through column 3, line 22. The hydrogen peroxide compositions of Narasimhan *et al.* are in liquid aqueous form at all times and stored as aqueous liquids (cf, Example 1) until they are mixed with aqueous alkaline solution immediately before use. This is opposite of Applicants' teaching as discussed above.

Moreover, the form of Applicants' present claims excludes liquid aqueous hydrogen peroxide and liquid crystals from Applicants' claimed granular composition. As stated in MPEP 904.01, "... the breadth of the claims in the application should be carefully noted; that is, the Examiner should be fully aware of what the claims do *not* call for, as well as what they do require." There is no teaching, suggestion or disclosure whatsoever of powdered, granular compositions by Narasimhan *et al.* Hence there is no teaching, suggestion or motivation for a person skilled in the art to logically look to Narasimhan *et al.* for guidance regarding granular compositions.

Further, as correctly noted by the Examiner, Narasimhan *et al.* do not teach either peroxy salts or all of Applicants' claimed conditioner species. On page 6 of the Office Action, however, the Examiner incorrectly states:

"It would have been *prima facie* obvious to one of ordinary skill in the art at the time the claimed invention was made to substitute persulfates for hydrogen peroxide in the composition taught by Narasimhan *et al.* and produce the instant invention."

Applicants respectfully submit that the foregoing statement is chemically erroneous and technically unsupported. There is no suggestion or motivation in the art to make the proposed substitution, because the Examiner's proposed modification would render the composition of Narasimhan *et al.* unsatisfactory for its intended purpose. See *In re Gordon*, 221 USPQ 1125

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(Fed Cir.1984) and MPEP 2143.01 (V). Narasimhan *et al.* require aqueous liquid hydrogen peroxide for bleaching. It is well known to persons skilled in the hair bleaching art that persulfates decompose quickly in aqueous solution and do not produce hydrogen peroxide. Substituting persulfates would also be unsuitable for producing a storable liquid aqueous composition as required by Narasimhan *et al.* (see Example 1).

The claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. (See MPEP 2143.01 (V) and (VI)). Here, substitution of persulfates for the hydrogen peroxide in the composition of Narasimhan *et al.* would render the composition of Narasimhan *et al.* unsatisfactory for its intended purpose. Narasimhan *et al.* require aqueous liquid hydrogen peroxide and do not teach or suggest solid hydrogen peroxide or peroxy salt boosters. Narasimhan *et al.*, therefore, teach away from Applicants' claimed invention.

Contrary to the Examiner's assertion on page 5 of the Office Action, the deficiencies in Narasimhan *et al.* are not cured by the teachings of the secondary references, Lorenz *et al.*, and Cincotta *et al.* The Office Action asserts that:

"Lorenz *et al.* teach, as a whole, a powdery hair bleaching (lightening) composition.

Lorenz *et al.* teach using peroxide salts such as potassium and ammonium persulfate as bleaching agents (column 2, lines 8-11). ..."

As pointed out above, and repeated herein, there is no teaching, suggestion or motivation in Narasimhan *et al.* to make any powdery hair bleaching compositions, or to use other than liquid, aqueous hydrogen peroxide with liquid crystal formation. Persulfates do not generate hydrogen peroxide, and it is commonly known by those skilled in the hair bleaching art, that solid peroxide compounds, capable of generating hydrogen peroxide, are not stable in aqueous solution. Contrary to the Examiner's finding on page 6, therefore, there is no reasonable rationale for motivating a skilled artisan to substitute persulfates for hydrogen peroxide in the composition of Narasimhan *et al.* from the teachings of Lorenz *et al.*, because the teachings of Lorenz *et al.* also are unsuitable for, and would render, the composition of Narasimhan *et al.* unsatisfactory for its intended purpose.

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In further supporting the rejection, the Examiner states:

"Cincotta *et al.* teach, as a whole, a non-aqueous (hence substantially anhydrous) composition to style hair which contains many hair conditioners (fixative, humectants, emollients, etc.)

Cincotta *et al.* teach a vast number of hair conditioners (as emollients) which may be included in combination in a hair active composition (paragraph 47). ..."

The teachings of Cincotta *et al.*, however, do not cure the deficiency in Narasimhan *et al.* even in combination with Lorenz *et al.* There is no teaching or suggestion in Lorenz *et al.* of any conditioner, let alone a combination of conditioners, such as Applicants' claimed conditioner species. There is no teaching or suggestion in Cincotta *et al.* of "powdery" compositions of any kind, or of a "hair active composition", or of concurrently conditioning the hair during any chemically reactive (i.e., hair active) treatment, e.g., bleaching, or of admixing the Cincotta *et al.* composition with any aqueous medium.

Cincotta *et al.* focus only on the problem of physically styling the hair and holding a hair style in place by topically applied compositions of vinyl copolymers in non-aqueous solvent. The composition of Cincotta *et al.*, therefore, is not chemically reactive, so the Examiner's assertion that it is a "hair active composition" is erroneous. The composition is a non-reactive liquid hair styling composition that can be applied on all types of hair, including hair that has been previously treated with chemically reactive compositions, and, unlike conventional hair bleach, the composition is left on the hair. Persons skilled in the hair styling and chemical hair treatment arts understand that bleaching and styling of hair are discreetly different treatments. Hair bleaching requires an aqueous composition for effectiveness, whereas holding the properties of a hair style is negatively affected by aqueous mediums. As such, it is not common to combine these treatments into a single composition.

Applicants respectfully submit there is no logical rationale or motivation found in Lorenz *et al.* and Cincotta *et al.* for a skilled artisan to incorporate the claimed conditioners into the composition of Narasimhan *et al.* as proposed by the Examiner. Cincotta *et al.* teach non-aqueous hair styling compositions to overcome the negative problems associated with aqueous hair styling compositions (see paragraph [0015] of the Pre-Grant published application US2002/0155962. Cincotta *et al.* teach away from using aqueous compositions, because to do so would negate the hair styling purpose of Cincotta *et al.* Hence, there is no suggestion or

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motivation to admix the composition of Cincotta *et al.* with an aqueous medium at all.

A *prima facie* case for obviousness requires that the asserted combination of references teaches or suggests all of the limitations of the rejected claims. *In re Royka*, 180 USPQ 580,583 (CCPA 1974). To establish a *prima facie* case of obviousness, the Examiner must show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). There is no suggestion to combine, however, if a reference teaches away from its combination with another source. *id.* 5 USPQ2d at 1599. As stated in MPEP 2141.03 (VI): "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W. L. Gore & Associates, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert denied*, 469 U.S. 851 (1984)...". There is no teaching, suggestion or motivation in the primary Narasimhan *et al.* reference of using granular compositions and hence lead away from the claimed invention. There is no teaching, suggestion or motivation in the secondary Lorenz *et al.* reference for conditioning the hair concurrently with bleaching and hence lead away from the claimed invention. There is no teaching, suggestion or motivation in the secondary Cincotta *et al.* reference of granular compositions or of admixing the composition of Cincotta *et al.* with any aqueous medium for use, which also leads away from the claimed invention. As stated in MPEP 2146 X-D(2): "It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). ...".

Here, the primary reference teaches away from the claimed composition and would clearly discourage a person skilled in the art from using the teachings of the secondary references. Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness for the invention as a whole. Neither Narasimhan *et al.*, Lorenz *et al.*, nor Cincotta *et al.*, alone or in combination render obvious Applicants' claimed combination. The art-based rejection of the pending claims 1, 3, 8, 9, and 35-40 as present of record, should be withdrawn.

Claims 10-17, 24, 25, 28-31 and 33 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Narasimhan *et al.*, Lorenz *et al.*, and Cincotta *et al.* as applied to claim 1 above, and further in view of Syed *et al.* (U.S. Patent 5,756,077). Applicants traverse this rejection in part by the record clarifying amendments to claims 10, 14, 24, and 31, and the following discussion.

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The inability of the primary Narasimhan, *et al.* reference, alone or in combination with, the secondary references, individually or collectively, to make obvious the present invention was discussed in detail above and is repeated herein by reference. The Examiner admits that: "The difference between the teachings of Narasimhan *et al.*, Lorenz, *et al.*, and Cincotta *et al.* and the instant claims is that Narasimhan *et al.*, Lorenz, *et al.*, and Cincotta *et al.* do not teach adding the specifically claimed hair protectants." Applicants disagree, however, with the Examiner's statement that: "This deficiency in Narasimhan *et al.*, Lorenz, *et al.*, and Cincotta *et al.* is cured by the teachings of Syed, *et al.*"

Although the Examiner correctly states that: "Syed, *et al.*, teach, as a whole, a method for protecting chemically treated hair and a kit for using the compositions to protect hair.", Syed *et al.* do not teach or suggest free-flowing, granular compositions, much less granular bleaching powders. The compositions of Syed *et al.* are aqueous liquids. Additionally, the compositions of Syed *et al.* are applied to previously damaged hair to protect the previously damaged hair by blocking the action of a subsequent treatment with the same chemical treatment.

In Applicants' claimed granular conditioning composition, the hair protectant ingredient is an optional, auxiliary ingredient, and not an essential ingredient as in the composition of Syed *et al.* In contrast to Syed *et al.*, when a hair protectant is present in Applicants' claimed composition, it is concurrently present during the subsequent chemical treatment (i.e., bleaching). There is no teaching, or suggestion, or motivation in Syed *et al.* to prepare a free-flowing, granular composition or the claimed conditioner species in Applicants' claimed combination of water dispersible, self-emulsifying fatty-acid derived conditioners. Thus that Syed *et al.* teach selective individual components recited in the withdrawn claim 22 and cancelled claim 26, cited by the Examiner, does not render the Applicants' claimed invention as a whole obvious either alone, or in combination with, the primary and secondary references. The art-based rejections of claims 10-17, 24-25, 28-31 and 33 should be withdrawn.

While a reference can be utilized for all that it teaches, focusing upon isolated portions of the reference or picking and choosing only that which supports a holding of obviousness is improper. *In re Wesslau*, 147 USPQ 391, 393 (CCPA 1965); *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ2d 1593, 1602 (Fed. Cir. 1987). The claimed invention must be considered as a whole; it is irrelevant to determining obviousness that some or all aspects of the claim may have been otherwise known in the art. *Jones v. Hardy*, 220 USPQ 1021, 1024 (Fed.

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Cir. 1984). References that merely indicate that isolated features recited in the claims are known in the art do not provide a sufficient basis for concluding that the rejected combination of claim elements would have been obvious, absent evidence of a motivating force which would impel a person of skill in the art to do what Applicant has done. *Ex parte Hiyamizu*, 10 USPQ2d 1393, 1394 (BPAI 1988) (The test is whether or not the references viewed individually and collectively would have suggested the claimed invention to the person possessing ordinary skill in the art), *Ex parte Levengood*, 28 USPQ2d 1300, 1301 (BPAI 1993).

Here not only is there is no suggestion or motivation in the prior art that would lead to Applicants' claimed invention, common sense would lead a skilled artisan away from combining the art as proposed by the Examiner. The Examiner has failed to articulate a rational underpinning of why one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious, as required. *KSR International Co. v. Teleflex, Inc.*, 82 USPQ2d 1385 at 1396 citing, *In re Kahn*, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), MPEP 2143.01 (V).

It is well established that each prior art reference must be evaluated in its entirety and that all of the prior art must be evaluated as a whole. The claimed invention as a whole must be considered. (See MPEP 2141.02 (I) which states: "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983)...").

In conclusion, Applicants submit that none of the cited prior art teaches, or suggests, or provides motivation for, Applicants' claimed conditioner species of specific water-dispersible, self-emulsifying, fatty-acid derived conditioners and Applicants' substantially anhydrous, free-flowing granular composition as set forth in the claims presented of record. Claims 1, 3, 8-17, 24-25, 28-31, 33 and 35-40 as presented of record are believed to be in condition for allowance.

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Applicants respectfully request withdrawal of the finality of the present Office Action, allowance of all of the claims, and early passage of the application to issue. In the event the finality of the present Office Action is maintained, Applicants request entry of this Amendment and Response into the record for placing the record in condition for Appeal.

Respectfully submitted,

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